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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/631,279 | 07/31/2003 | Keith A. Raniere | FIRS-2992 | 3766 |
| 5409 | 7590 | 04/04/2006 | EXAMINER | |
| SCHMEISER, OLSEN & WATTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110 | | | HARRIS, CHANDA L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3715 | |

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,279

Applicant(s)

RANIERE, KEITH A.

Examiner

Chanda L. Harris

Art Unit

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/11/06, 7/31/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 17-20, drawn to a method of determining if a subject is trainable a method comprising a performance system, classified in class 434, subclass 247.
- II. Claims 9-16, drawn to a method of taking measurement and training a subject, classified in class 482, subclass 8.
- III. Claims 21-33, drawn to an apparatus comprising a sensor and a control system, classified in class 482, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as a method that does not require taking a measurement relating to at least one continuous variable with respect to which a subject may remain in a state of accommodation. See MPEP § 806.05(d).

Art Unit: 3715

2. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as a method that does not require at least one sensor and a control system. See MPEP § 806.05(d).

3. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as an apparatus that does not require taking a measurement relating to at least one continuous variable with respect to which a subject may remain in a state of accommodation. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Arlen Olsen on 3/29/06, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8 and 17-20. Affirmation of this election must be made by applicant in replying to this Office

Art Unit: 3715

action. Claims 9-16 and 21-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statement filed 7/31/03 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the electronic documents are in improper format. See MPEP 707.05(e) for guidelines for the proper citation of electronic documents. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-8 and 17-20 do not produce a useful, concrete and tangible result and thereby do not provide a practical application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips (US 6,592,502).

1. [Claim 1]: Regarding Claim 1, Phillips discloses determining if a subject (i.e., athlete, cardiovascularly handicapped heart patients) is trainable with respect to the performance of a given activity. See Abstract.
2. [Claim 2]: Regarding Claim 2, Phillips discloses determining a point of efficiency (i.e., enhanced cardiovascular capability and muscular development), of a subject with respect to at least one parameter (e.g., blood pressure). See Col.9: 23-26, 43-46.
3. [Claim 3]: Regarding Claim 3, Phillips discloses exerting the subject at or near the point of efficiency until a state of inefficiency (i.e., ischemia) with respect to the at least one parameter or exhaustion (i.e., unable to keep up). See Col.20: 19-26.
4. [Claims 4,18]: Regarding Claims 4 and 18, Phillips discloses wherein the at least one parameter is one of a physical parameter, emotional parameter, and mental parameter of the subject. See Col.9: 43-46 and Col.20: 19-26.

Art Unit: 3715

5. [Claims 5,19]: Regarding Claims 5 and 19, Phillips discloses wherein the at least one physical parameter is selected from the group consisting of running turnover rate, stride length, stride stroke force, muscle contraction speed, muscle contraction profile, muscle contraction strength, weight lifted, electromagnetic activity profile, chemical activity profile, body temperature, and blood pressure. See Col.9: 43-46.
6. [Claims 6,20]: Regarding Claims 6 and 20, Phillips discloses wherein the at least one physical parameter is selected from the group consisting of heart rate, heart beat strength, respiration rate, VO_2 , perspiration rate, metabolic rate, blood flow (i.e., ischemia), breathing rate, heat given off, and breath length. See Col.20: 24-26.
7. [Claim 7]: Regarding Claim 7, Phillips discloses wherein the at least one parameter is observed by a signal selected from the group verbal utterance, physical motion (i.e., unable to keep up). See Col.20: 24-26.
8. [Claim 8]: Regarding Claim 8, Phillips discloses wherein the subject is selected from the group consisting of an animal, a human (i.e., heart patient), a group of humans, a group of animals, a cellular automata, a group of cellular automata, microbes, plants, and a computer program and data. See Col.20: 24-26.
9. [Claim 17]: Regarding Claim 17, Phillips discloses providing a performance system (i.e., RRE apparatus) and activating the performance system. See Col.11: 6-26. Phillips discloses recording at least one parameter of the performance system (i.e., pressure). See Col.12: 6-10. Phillips discloses measuring at least one parameter of a subject (i.e., participant applied power). See Col.12: 6-10. Phillips discloses determining at least one point of efficiency parameter by changing the at least one

parameter of the performance system (e.g., resistive mechanical impedance level) until the at least one parameter of the subject substantially changes beyond a given tolerance function and training the subject at or near the point of efficiency so the duration the subject can maintain the point of efficiency changes (i.e., As the participant becomes experienced, he or she can increase exercise time and/or stroke and pace in order to increase applied power and total applied energy values). See Col.13: 17-35.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 571-272-4448. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/631,279
Art Unit: 3715

Page 8

Chanda L. Harris
Chanda L. Harris
Primary Examiner
Art Unit 3715